REMARKS

Claims 1-31, 33-37, 39-43 and 46-57 are pending in this application. All pending claims were rejected under 35 U.S.C. §103 as being unpatentable over Casey in view of Ylonen further in view of Mauger. No claims are currently amended. Reconsideration is respectfully requested.

The presently claimed invention is a novel transmission of a packet from a first MPLS network segment to a second MPLS network segment via an intermediate, non-MPLS network segment utilizing tunneling to preserve labels in a stack. The Office relies on each of the cited references for teaching particular ones of the elements of the claimed invention. In particular, the Office relies on Casey for showing transmission of a packet from a first MPLS domain to a second MPLS domain via a non-MPLS domain, Ylonen for teaching tunneling and encapsulation, and Mauger for teaching a label stack. Applicant does not claim to invented the general concepts of MPLS and tunneling by way of this application so Ylonen and Mauger need not be discussed in detail. Casey, however, fails to even suggest the problem of traversing an intermediate, non-MPLS segment. In particular, in the lengthy passage of Casey cited by the Office (col. 6, line 15 through col. 8, line 35) there is not a single mention of moving a packet from a first MPLS segment to a second MPLS network segment via a non-MPLS segment. Indeed, the term "MPLS" does not even appear anywhere in the cited passage. Surely if the claimed element was known there would be a reference showing traversal of a non-MPLS network segment between two MPLS network segments. Because the cited references fail to show all of the claim limitations withdrawal of the rejections of claims 1-31, 33-37, 39-43 and 46-57 is respectfully requested.

Assuming, *arguendo*, that the cited references taken in combination actually showed all of the claim elements, the combination itself is improper. A *prima facie* case of obviousness under 35 U.S.C. §103 must include a showing of a suggestion, teaching or motivation that would have led a person of ordinary skill in the art to combine the cited references *in the particular manner claimed*. See In re Dembiczak, 175 F.3d 994, 998 (Fed. Cir. 1999), and In re Kotzab, 217 F.3d 1365, 1371 (Fed. Cir. 2000). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In this case, the Office has not established that a person or ordinary skill in the art would be motivated to combine the cited combinations of references in the particular manner of the corresponding rejected claims. Indeed, the references do not even recognize the problem solved by the claimed invention.

Applicants have made a diligent effort to place the claims in condition for allowance. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Holmes W. Anderson, Applicants' Attorney at 978-264-6664 (ext. 305) so that such issues may be resolved as expeditiously as possible.

For these reasons, and in view of the above amendments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,

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Date

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